

## REMARKS/ARGUMENTS

Claims 36-71 were previously pending. As noted above, claims 36, 45, 54, and 63-71 have been amended, no claims have been canceled, and claims 72-76 have been added. Support for these amendments may be found throughout the Specification.<sup>1</sup> Thus, claims 36-76 are now pending.

Applicants respectfully request reconsideration of this application based on the following remarks.

### *Claim Objections*

Claims 64-71 are objected to because of informalities. Claims 64-71 are dependent to independent claim 63 (a computer readable media embodying a program.....) and should be referred to preamble of claim 63 for consistency. Applicant has revised the claims to overcome this objection.

Therefore, based on the foregoing, Applicants respectfully request that the Examiner withdraw the objection to claims 64-71.

### *Claim Rejections – 35 USC § 112*

Claim 1 is rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has revised claim 36 to overcome this rejection.

Therefore, based on the foregoing, Applicants respectfully request that the Examiner withdraw the rejection of claim 1 (claim 36) under 35 USC § 112, second paragraph.

Claims 38, 47, 56 and 65 are rejected under 35 USC § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection.

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<sup>1</sup> See, e.g., Specification, paragraphs [0016] and [0026] to [0029].

The Action asserts that the specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in the art to recognize the step of “performing at least one of said receiving, recognizing, identifying, assigning, and initiating in a background mode.” Applicants respectfully disagree. The specification discloses that “the data collected and transferred is unknown to the user” in paragraph [0026]. The use of the phrase “unknown to the user” with respect to performing the described actions reasonably conveys to one skilled in the relevant art that the data transfer may be performed in a background mode.

Furthermore, the specification discloses the following in paragraph [0029]:

Criteria in the set or any subset can include a wide range of options such as, for example, to allow for *an optimal time for data transfer* such as, for example, *for late at night use over the Internet, ...*, etc. ... The intent here is not to list all possible criteria but to provide a number of possible criteria such that an understanding can be made that the widest possible range of criteria should be available for consideration. (Emphasis added)

As noted in the above cited text, “for late at night use over the Internet” reasonably conveys to one skilled in the relevant art that the data transfer may be performed in a background mode.

Furthermore, original claim 4 (now canceled) and current claims 37, 46, 55, and 64 refer to either “a level of user activity” or “a user activity level,” with reference to the set of criteria. This language, either by its self or in combination with the above cited text from paragraph [0029] conveys to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the method of performing at least one of said receiving, recognizing, identifying, assigning, and initiating in a background mode.

Therefore, based on the foregoing, Applicants respectfully request that the Examiner withdraw the rejection of claims 38, 47, 56 and 65 under 35 USC § 112, first paragraph.

#### ***Claim Rejections – 35 USC § 103***

Claims 36-71 are rejected under 35 USC § 103(a) as being unpatentable over Evans et al (Hereafter “Evans”) US Patent No. 6,690,918 in view of Spratt (Hereafter “Spratt”) US Patent Application Publication No. 2002/0040326. Applicants respectfully traverse this rejection.

Independent claims 36, 45, 54 and 63 are patentable over the cited references, as there is no combination of Evans and Spratt that discloses or suggest each and every feature recited by the claims. In particular, the combination of the cited references fails to disclose or suggest a method, device, or machine-readable medium that includes, at least, the action of, a component for, instructions for causing a processor to perform the action of, or a means for

receiving one or more registrations, wherein each registration comprises a set of criteria for transferring data, the set of criteria comprising at least one triggering event; ...

identifying, based on an occurrence of at least one of the at least one triggering event, registrations in the first entity whose associated set of criteria has been met;

assigning priority indicators to the identified registrations; and  
initiating a transfer over the communication link to transfer data associated with the identified registrations based on the priority indicators.

as recited by independent claims 36, 45, 54 and 63.

To establish a *prima facie* case of obviousness, all of the claimed features must be taught or suggested by the references and there must be some suggestion or motivation, in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.<sup>2</sup>

Firstly, neither Evans nor Spratt disclose or suggest the set of criteria comprising at least one triggering event. Evans does not disclose or suggest any identifying of registrations based on occurrence of a triggering event, nor prioritizing such identified registrations before being transferred. The profiles disclosed in Evans are created in a condition ready to be priority matched with other profiles. Therefore the profiles in Evans do not disclose or suggest the registrations that must fulfill a triggering event before they may be identified to be transferred, as disclosed in the current application. Similarly, Spratt discloses a preferences profile that is created in a condition ready to be transferred to a service provider. Therefore the preferences profile disclosed in Spratt does not disclose or suggest the registrations that must fulfill a triggering event before they may be identified to be transferred, as presently recited.

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<sup>2</sup> MPEP, section 2142.

Secondly, neither Evans nor Spratt disclose or suggest assigning priority indicators to the identified registrations. Rather than assigning priority indicators to the identified registrations, Evans discloses priority matching of “profiles of those persons within his location.”<sup>3</sup> Evans discloses priority matching of profiles *between* entities or persons and does not disclose or suggest assigning priority indicators to the identified registrations *within* an entity. Similarly, Spratt discloses population of a preferences profile on a user device through monitoring the user activity on the device.<sup>4</sup> Spratt does not disclose or suggest assigning priority indicators to the *identified registrations*. As noted above, the content used to populate the preferences profile in Spratt does not include at least one triggering event that provides a basis for identifying the registrations for prioritization and transfer. Therefore as the content disclosed in Spratt has no triggering event that occurs before the content is identified and used to populate the preferences profile, Spratt cannot disclose or suggest assigning priority indicators to the *identified registrations*.

Thirdly, the Action concedes that Evans does not explicitly teach transferring data associated with the identified registrations (profile) based on the priority indicators. Spratt fails to correct the shortcoming of Evans in suggesting this aspect of the claim language. Rather than initiating a transfer over the communication link to transfer data associated with the identified registrations based on the priority indicators, Spratt discloses that the “preferences profile is used to select what items are downloaded to the device.”<sup>5</sup> In other words, Spratt discloses transferring data associated with the preferences profile from an entity to a service provider to facilitate subsequent downloading of content from the service provider to the entity. As noted above, Spratt does not disclose or suggest transferring data associated with the identified registrations based on the priority indicator. Further, Spratt does not disclose or suggest any triggering event that occurs before content is evaluated by the preferences profile.

Thus, independent claims 36, 45, 54 and 63 are patentable over any combination of Evans and Spratt based at least on their failure to disclose or suggest assigning priority indicators to the identified registrations.

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<sup>3</sup> Evans, col. 8, lines 63 to 65.

<sup>4</sup> Spratt, paragraphs [0036] to [0041].

<sup>5</sup> Spratt, paragraph [0043].

Claims 37-44, 46-53, 55-62, and 64-72 depend from one of the independent claims, and thus are allowable for at least the same reasons. Additionally, each of these claims separately recites a combination of subject matter that is not disclosed or suggested by any combination of the cited references.

Therefore, based on the foregoing, Applicants respectfully request that the Examiner withdraw the rejection of claims 36-71 under 35 USC § 103 (a) as being unpatentable over Evans in view of Spratt.

### CONCLUSION

In light of these remarks, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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